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LERNER, DAVID, LITTENBERG, KRUHMOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			JOHNS, CHRISTOPHER C	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/699,984	AIDA ET AL.
	<b>Examiner</b> Christopher C. Johns	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 July 2010.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,6 and 19 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,6 and 19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsman's Patent Drawing Review (PTO-215)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 July 2010 has been entered.

### **Acknowledgements**

2. This Office Action is given Paper No. 20110106 for reference purposes only.
3. This Office Action is in response to the Request for Continued Examination, filed by Applicants on 30 July 2010 ("July 2010 RCE"). The July 2010 RCE contained, inter alia, Claim Amendments ("July 2010 Amendments") and Remarks/Arguments ("July 2010 Remarks").
4. Claims 1, 6, and 19 are pending.
5. Claims 1, 6, and 19 have been examined.

### **Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1, 6, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Independent claim 1 recites “cause information to be supplied . . . which identifies each electronic device currently available to receive the selected software by transfer if a request to do so is made” (page 2, limitation (v), lines 32-35). The recitation of “if a request to do so is made” renders the claim indefinite because a person having ordinary skill in the art would not understand whether:

- a. the information is “supplied to the respective electronic device” only “if a request to transfer the data is “made;” or
- b. the information on which devices are available to “receive the selected software by transfer” is always sent to the electronic device, so that “if” the electronic device is used to formulate such a “request,” the information is readily available.

9. Because a person having ordinary skill in the art’s attempt to interpret the claim language would result in two or more structurally dissimilar interpretations, a person having ordinary skill in the art would not be able to reasonably interpret the structure of the claim. Thus, the claim language is indefinite. As such, the USPTO is justified in requiring the Applicant to more precisely define the metes and bounds of the claimed invention. For further guidance on this matter, see page 2, ¶1 of “Indefiniteness rejections under 35 U.S.C. 112, second paragraph (signed 2 September 2008),” located at the USPTO’s website:

<http://www.uspto.gov/web/patents/memoranda.htm>.

10. Claims 6 (page 5, limitation (iv), lines 8-11) and 19 (page 7, lines 5-8) contain similar recitations, and are therefore rejected for similar reasons.

11. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance

with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

### **Claim Rejections - 35 USC § 103**

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 6, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0184515 ("Oho") in view of U.S. Patent 6,732,106 ("Okamoto").

14. As per claim 1, Oho discloses:

15. a server (figure 49, Rights Management Unit **41**) programmed to provide software (figure 49, Content Data **Dcnt**; [0105] notes that Dcnt can be "application software") via a network (figure 49, Transmission Path **61**) in response to a request to purchase or transfer the same (figure 51, Generate and Transmit Second Setting Request **S103**);

16. at least two electronic devices (figure 48, Devices **51a**, **51b**), each of the at least two electronic devices being identified by device identification information (figure 50, Device Identifier **Idva**; [0263] - "device identifier Idva") registered in association with user identification information identifying a single user (user identification information must inherently be sent in figure 51, step **S103**, because the Rights Management Unit **41** needs to

know information in order to “authenticate” the user) such that each of the at least two electronic devices have the same user associated therewith ([0262] - “any one of the units 21 belonging to the user β”);

17. each of the at least two electronic devices including a first central processing unit programmed (CPUs are inherent in electronic devices because they enable data to be operated upon) to cause the user identification information (user identification information must inherently be sent in figure 51, step **S103**, because the Rights Management Unit **41** needs to know information in order to “authenticate” the user) and the device identification information for the respective electronic device (figure 53, Device Identifier **Idvb**), and software identification information for selected software (figure 53, Content Identifier **Icnt**), to be sent to the server to request that the selected software be provided (figure 51, Generate and Transmit Second Setting Request **S103**);

18. to cause the selected software provided from the server to be installed (figure 51, Store Data **S19**) after the user identification information and the device identification information for the respective electronic device, and the software identification information for the selected software, has been sent to the server (figure 51, the storing of the data in **S19** only happens after Generate and Transmit Second Setting Request **S103**);

19. to cause the software identification information for the installed software (figure 14A, Content Identifier **Icnt**), the user identification information (user identification information must inherently be sent in figure 11, step **S22**, because the Rights Management Unit **41** needs to know information in order to “authenticate” the user), and the device identification information for the respective electronic device (figure 14A, Device Identifier **Idvb**) to be sent to the server (figure

11, Rights Management Unit 11) so as to request that a license required to run the selected software be generated based on predetermined license generating information (figure 12, Assembly License Information S210) and be provided to the electronic device (figure 12, Transmit License Information S211; [0256] notes that while the first embodiment is a separate embodiment from the second embodiment, the “device 51a receives the license information Dlca (see First Embodiment) from the rights management unit 41...”);

20. to cause the selected software to be run using the license (figure 12, Reproduce Content S220);

21. to cause a request that the server transfer the selected software from the respective electronic device to another of the at least two electronic devices (figure 51, Generate and Transmit Second Setting Request S103) which has the same user associated therewith (note in figure 48 that Licensee  $\beta$  possesses both devices 51a and 51b) as that of the respective electronic device;

22. the server (figure 49, Rights Management Unit 41) including a second central processing unit (CPUs are inherent in electronic devices because they enable data to be operated upon) to cause registration (figure 51, Newly Register Rights Record S1022) of the software identification information for the selected software in association with the user identification information and the device identification information (Device Identifier Idvb and Content Identifier Icnt are both sent with the Second Setting Request in figure 53; user identification information must inherently be sent in figure 51, step S103, because the Rights Management Unit 41 needs to know information in order to “authenticate” the user) for the respective electronic device (figure 48, device 51b);

23. to cause the selected software to be provided to the respective electronic device (figure 51, Transmit Data **S17**);
24. to receive (figure 11, User Authentication **S22** - receives the “Issue Request”) the software identification information for the installed software (figure 14A, Content Identifier **Idct**), the user identification information (user identification information must inherently be sent in figure 11, step **S22**, because the Rights Management Unit **41** needs to know information in order to “authenticate” the user), and the device identification information (figure 14A, Device Identifier **Idvb**), for the respective electronic device from the respective electronic device (figure 11, Device **21b**), after receipt thereof to determine (figure 11, Register Rights Record? **S24** and Is Right Providable? **S25**) whether the software identification information, the user identification information, and the device identification information for the respective electronic device have been previously registered in association with each other ([0161] - “rights DB 114 (see FIG. 7B) is referred to see whether it carries a rights record Rrgt including the same set as the extracted device identifier Idvb and content identifier Idct (step **S24**)”);
25. to cause generation of the license (figure 12, Assembly License Information **S210**) when a determination result indicates that the software identification information, the user identification information, and the device identification information for the respective electronic device have been previously registered in association with each other (the Assembly License Information in figure 12, step **S210** only happens if step **S24** is satisfied);
26. the software identification information for the selected software and the user identification information and the device identification information registered in association with the software identification information for the respective electronic device to be deleted (figure

45, Delete Device Identifier from Licensee Record **S94**; note that [0263] notes that the embodiments may be combined - “present license information management system Sb becomes capable of adding or deleting the device identifier Idva and/or Idvb by having the rights management unit 41 and the units 51a and 51b go through the processes as described in the second to fifth modified examples above”;

27. the software identification information for the selected software to be registered (figure 51, Newly Register Rights Record **S1022**) in association with the device identification information for the another electronic device and the user identification information, such that the respective electronic device is prohibited from purchasing software (when deleting the device identifier from the rights record in figure 45, step **S94**, the device is no longer able to use the system) and such that the another electronic device is allowed to run the selected software (when a new device is added to the system, as in figure 51, Newly Register Rights Record **S1022**, that device is now able to run the software acquired).

28. Oho does not explicitly disclose:

29. to cause information to be supplied to the respective electronic device which identifies each electronic device currently available to receive the selected software by transfer if a request to do so is made;

30. electronic device is selected by use of the information which identifies said each electronic device currently available to receive the selected software by transfer;

31. to cause, upon a request by the respective electronic device to transfer the selected software to the another electronic device, the information to be provided which identifies said

each electronic device currently available to receive the selected software by transfer to the respective electronic device to enable a selection.

32. Okamoto teaches:

33. to cause information to be supplied (column 14, lines 54-64 - "distribution front end 1011 creates a screen such as the one shown in FIG. 8, which displays...a list of device IDs 1021 that have been identified") to the respective electronic device (figure 10, User Device **1002**) which identifies each electronic device currently available to receive the selected software by transfer if a request to do so is made (figure 26, Display Valid Devices **S2611**);

34. electronic device is selected by use of the information which identifies said each electronic device currently available to receive the selected software by transfer (figure 26, User Selects Download Location **S2612**);

35. server (figure 10, Distribution Server **1001**) including a CPU to cause, upon a request by the respective electronic device to transfer the selected software to the another electronic device (figure 26, User Selects Download Location **S2612**), the information to be provided which identifies said each electronic device currently available to receive the selected software by transfer to the respective electronic device to enable a selection (column 14, lines 54-64 - "a list of device IDs 1021 that have been identified").

36. Okamoto's system is one that solves the difficulty of a user changing from one device to another device - column 2, lines 35-40 note that it is typically difficult to transfer this sort of information. By using the system in Okamoto, a user will be more able to exercise control over his purchased media, creating a more convenient system for its users. This, in turn, creates a

more profitable system for its owners, because users are more likely to use a convenient system (as opposed to an inconvenient system).

37. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Oho the device selection system as taught by Okamoto, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more convenient and profitable system.

38. The Examiner finds that claim 6 is not patentably distinct from claim 1, because the inventions in claims 1 and 6 are related as subcombinations disclosed as usable together in a single combination. The subcombinations would be distinct if they did not overlap in scope and were not obvious variants, and if it were shown that at least one subcombination were separately usable. In the instant case, neither subcombination is separately usable (they are used for the same purpose and have the same result), the subcombinations overlap in scope (both drawn to systems for providing software), and are obvious variants of one another. See MPEP § 806.05(d).

39. Because claim 6 is not patentably distinct from claim 1, the Examiner concludes that the patentability of claim 6 stands or falls with claim 1.

40. The Examiner finds that claim 19 is not patentably distinct from claim 1, because the inventions in claims 1 and 19 are related as process and apparatus for its practice. The

inventions would be distinct if it could be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method in claim 19 is practiced only by the system in claim 1, and the system in claim 1 only practices the method in claim 19.

41. Because claim 19 is not patentably distinct from claim 1, the Examiner concludes that the patentability of claim 19 stands or falls with claim 1.

#### **Response to Arguments**

42. Applicants' arguments with respect to claims 1, 6, and 19 have been considered but are moot in view of the new grounds of rejection.

#### **Conclusion**

43. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The Examiner can normally be reached from Monday through Friday from 9am to 5pm. The Examiner's direct fax line is (571) 270-4462.

44. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Christopher C Johns/  
Examiner, Art Unit 3621